

FILE NO. AP33001-070457.0972

PATENT

**Remarks****Summary of Office Action**

Claims 1-10 are pending.

Claims 1, 3, 7 and 9 have been rejected under 35 U.S.C. § 112 as being indefinite. Further, claims 1 and 3 have been rejected under 35 U.S.C. § 102(a) as being anticipated by Paltenghe U.S. Patent Application Publication No. 2002/0004783 ("Paltenghe"). Claims 2 and 4-10 have been rejected under 35 U.S.C. § 102(a) as being obvious from Paltenghe in view of Chaum et al. U.S. Patent Serial No. 6,434,238 ("Chaum").

The Examiner has noted that the specification does not have proper reference to the priority application and that the inventor declaration has a typographical error in the claimed priority application serial number.

**Applicants Reply****Inventor declaration**

Applicants appreciate the Examiner's kind identification of the informality in the inventor declaration. The undersigned attorney is preparing a new declaration, which correctly identifies the priority application number, for the inventor's signature. This new declaration will be submitted shortly.

**Reference to priority application**

With respect to the a proper reference to priority applications in the specification, applicants have previously submitted a Preliminary Amendment to provide such proper reference in the specification. Applicants request entry of the Preliminary Amendment (filed May 14, 2001), which meets the 37 C.F.R. 1.60 requirements.

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§ 112 rejections

Applicants have amended the claim 1, 3, 7 and 9 so that they are now definite and conform to all requirements of § 112. In particular the objected-to phrase "substantially compliant" has been replaced by the definitive "compliant" so that claims 1, 3, 7 and 9 all call for "a format compliant with a chip card electronic commerce protocol or specification."

Prior art rejections

Applicants have amended claims 1, 3, 6, and 8 to further clarify the invention. Applicants respectfully traverse the claim rejections under § 102(a) and § 103(a).

Independent claims 1, 3, 6 and 8

Applicants' invention, relates to methods and apparatus for conducting a payment card transaction over a computer network between a consumer and a merchant. In particular, applicants' invention is directed to methods and systems (including wallet servers) by which recent chip payment card technology is seamlessly integrated into existing or legacy payment infrastructures that do not support chip payment cards. (See e.g., Summary of Invention, page 7 last paragraph). Applicants have amended claims 1, 3, 6 and 8 to highlight this feature. In particular these claims have been amended to explicitly recite that the payment card "the payment card is either issued by an issuer institution having infrastructure to support chip card transactions or issued by an issuer institution having legacy infrastructure supporting only non-chip card transactions" and that the respective method (claims 1 and 6) and wallet servers (claims 3 and 8) are suitably configured to accomplish the transaction in both cases: "when the payment card is either issued by an issuer institution having infrastructure to support chip card transactions or issued by an issuer institution having legacy infrastructure supporting only non-chip card transaction".

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Applicants respectfully submit that neither of the cited references shows this feature of applicants' invention for seamless integration legacy and new payment technologies, as recited in claims 1, 3 and 8.

Paltenghe relates to improvements in conventional electronic wallet software (See e.g., Paltenghe, Background Section). The Examiner correctly notes (see Office Action, page 3, ¶6) that Paltenghe describes a virtual wallet system including a wallet server. However, applicants note that Paltenghe does not describe a method or wallet server configured for dual use (i.e., with both chip payment card and non-chip payment cards. Further, Chaum does not describe or suggest wallet servers.

In particular, neither Paltenghe nor Chaum show, teach or suggest methods or wallet servers configured to conduct transactions "regardless of whether or not the payment card of the consumer involved in the transaction is a chip card or a non-chip card" as required by claims 1, 3, 6 and 8.

For at least this reason, these independent claims 1, 3, 6 and 8 are patentable over the cited references — Paltenghe and Chaum, viewed independently or in combination. Further the dependent claims 1, 4, 5, 7, 8, 9 and 10 are patentable for at least the same reasons.

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Conclusion

This application is now in condition for allowance. Reconsideration and prompt allowance of which are requested. If there are any remaining issues to be resolved, applicant respectfully requests the Examiner to kindly contact the undersigned attorney by telephone for an interview.

Respectfully submitted,  
BAKER BOTTS L.L.P.

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